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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,964	01/29/2004	William A. Margiloff	E03.001/U	4330

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BUCKLEY, MASCHOFF & TALWALKAR LLC
50 LOCUST AVENUE
NEW CANAAN, CT 06840

EXAMINER

ORR, HENRY W

ART UNIT	PAPER NUMBER
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2176

MAIL DATE	DELIVERY MODE
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09/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/766,964

Applicant(s)

MARGILOFF ET AL.

Examiner

Henry Orr

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 13-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 13-16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to applicant's amendment dated 7/23/2007.
2. Claims 1-4, 6, 13-16 and 18 are pending in the case.
3. Claims 5, 7-12, 17, 19 and 20 are cancelled.
4. Claims 1 and 13 are independent claims.

Applicant's Response

5. In Applicant's response dated 7/23/2007, applicant has amended the following:
 - a) Specification
 - b) Claims 1, 13 and 18

Based on Applicant's amendments and remarks, the following objections and rejections previously set forth in Office Action dated 2/23/2007 are withdrawn:

- a) Objection to Drawings

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 1-4, 6, 13-16 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the**

inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 13:

Claims 1 and 13 recites (emphasis added): "providing to a user an initial set of toolbar buttons in a toolbar **without providing to the user a subsequent set of toolbar buttons in the toolbar**; receiving a single indication from the user; replacing the initial set of toolbar buttons with the subsequent set of toolbar buttons in the toolbar in response to the received indication such that the initial and subsequent sets of toolbar buttons **are not simultaneously provided to the user in the toolbar.**".

There is no mention of the newly amended limitation in the original Specification. Thus, the limitations include subject matter that was not described in the original Specification.

If the examiner has overlooked the portion of the original Specification that describes this feature of the present invention, then Applicant should point it out (by page number and line number) in the response to this Office Action.

Applicant may obviate this rejection by canceling the claim.

Claims 2-4, 6, 14-16 and 18:

Dependent claims 2-4, 6, 14-16 and 18 are rejected for fully incorporating the deficiencies of their respective base claims.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 1-4, 6, 13-16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Sommer, U.S Publication Application No. 2004/0100504 A1 with a provisional filing date of May 24, 2002.**

Claim 1:

Sommer teaches *"an item selection system in which a first menu is positioned in a first menu space, a second menu space, a second menu is positioned in a second menu space, and when a cursor selects a particular item from the first menu, the second menu replaces the first menu"* (see par. 7). **(claim 1; i.e., providing to a user an initial set of toolbar buttons in a toolbar without providing to the user a subsequent set of toolbar buttons in the toolbar; receiving a single indication from the user; replacing the initial set of toolbar buttons with the subsequent set of toolbar buttons in the toolbar in response to the received indication such that the initial and subsequent sets of toolbar buttons are not simultaneously provided to the user in the toolbar.)**

Examiner interprets the items on the menu as equivalent to toolbar buttons in a toolbar because applicant admitted in the applicant's specification that a "toolbar" refers to a graphical user interface having one or more buttons, icons, menus, and/or other user selectable features operable to send a command, trigger an event (Applicant specification; p. 4 lines 14-18). Therefore, the items on the first menu graphical user interface represent the buttons that can trigger an event. Examiner also interprets when the cursor selects as a single indication from the user and the provided items on the second menu as a subsequent set of toolbar buttons.

Claim 2:

Sommer teaches *"When the cursor moves from the particular item to a further item within the first menu, the second menu changes"* (see par. 9). **(claim 2; i.e., providing to the user additional sets of toolbar buttons in the toolbar at least in part in response to additional received indications.)** Examiner interprets the cursor moving within the first menu as additional received indications. The additional sets of toolbar buttons are provided when the second menu changes.

Claim 3:

Sommer's Figure 2 illustrates that the initial set of items on the first menu are capable of being related to a common class of functionality (see Figure 2, par. 28). **(claim 3; i.e., wherein each toolbar button within the initial set of toolbar buttons is related to a common class of functionality.)** Examiner interprets the items on the

first menu shown on level 1 in Figure 2 to be capable of being related to a common class of functionality such as online purchasing or online browsing because the item selection system can be used in a hotel video on-demand system which provides a hotel guest with an user-friendly interface for selecting movies and other audio-visual products.

Claim 4:

Sommer's Figure 2 illustrates that the items on the second menu are capable of being related to a common class of functionality (see Figure 2, par. 32). **(claim 4; i.e., wherein each toolbar button within the subsequent set of toolbar buttons is related to a common class of functionality.)** Examiner interprets the items on the second menu shown on level 2 in Figure 2 to be capable of being related to a common class of functionality such as movie browsing because each item may correspond to a type of movie (see par. 34).

Claim 6:

Sommer's Figure 1 illustrates a search feature user input portion that is not replaced when the subsequent item buttons of the second menu replaces the initial item buttons on the first menu (see Figure 1, par. 28). **(claim 6; i.e., wherein the toolbar includes a search feature user input portion in addition to the initial set of toolbar buttons, and the search feature user input portion is not replaced by the subsequent set of toolbar buttons.)** Examiner interprets selecting the item on any

menu as the search feature user input portion that remains after the first menu is replace by the second menu.

Claims 13, 14, 15, 16 and 18:

Claims 13, 14, 15, 16 and 18 are apparatus claims and are substantially encompassed in method claims 1, 2, 3, 4 and 6 respectively; therefore the apparatus claims are rejected under the same rationale as method claims 1, 2, 3, 4 and 6 above. In respect to the processor and storage device of the apparatus claims, Sommer discloses the item selection system being displayed on computer screen which would inherently require a storage device and processor for executing the user-friendly interface program to perform the limitations of claims 13, 14, 15, 16 and 18 (see par. 28).

Response to Arguments

10. Applicant's arguments filed 7/23/2007 have been fully considered but they are not persuasive.

Rejections under 35 U.S.C. 102(e):

In respect to newly amended independent claims 1 and 13, Applicant argues Sommer does not disclose providing to a user an initial set of toolbar buttons in a toolbar without providing to the user a subsequent set of toolbar buttons in the toolbar.

See Response Page -7 last full paragraph.

Examiner disagrees.

Examiner agrees with Applicant that Sommer discloses that a first menu 140 ("initial set of toolbar buttons") may be displayed to a user in Figure 1. See Response Page-7 4th full paragraph. Therefore, the first menu is the initial set of toolbar buttons in a toolbar that is displayed without providing to the user a subsequent set of toolbar buttons such as a second menu.

Examiner agrees with Applicant that Sommer discloses that when a cursor is positioned over an item in the first menu 140, a second menu 145 may be displayed to the user in addition to the first menu 140. See Response Page-7 4th full paragraph. Therefore, by applicant own admission, *initially*, the first menu is displayed without a subsequent set of toolbar buttons. It is only when the cursor is position over the first menu; the subsequent set of toolbar buttons is provided to the user.

In respect to newly amended independent claims 1 and 13, Applicant argues Sommer does not disclose replacing the initial set of toolbar buttons with the subsequent set of toolbar buttons in the toolbar in response to the received indication such that the initial and subsequent sets of toolbar buttons are not simultaneously provided to the user in the toolbar. See Response Page -8 1st full paragraph.

Examiner disagrees.

Sommer discloses replacing the first menu in response to a received indication such that the first menu and the second menu are not simultaneously provided to the user in the toolbar. The first menu and the second menu are simultaneously provided to the user when the second menu is *not* replacing the first menu. Therefore, when the

second menu is replacing the first menu, the first menu may no longer be provided to the user (see par. 7, Figure 8-9).

In respect to newly amended independent claims 6 and 18, Applicant argues Sommer does not disclose a search feature user input portion in addition to the initial set of toolbar buttons, and the search feature user input portion is not replaced by the subsequent set of toolbar buttons. See Response Page –8 2nd full paragraph.

Examiner disagrees.

Sommer discloses a search feature user input portion with every menu displayed. The user is able to select a first menu to search items on a second menu. The search feature user input portion is on the first menu because the user inputs via cursor on a portion of the first menu to search items on a second menu that is displayed. When the second menu replaces the first menu, the user is still able to select the second menu via cursor to search items on a third menu that is displayed. Therefore, the search feature user input portion is not replaced by subsequent set of toolbar buttons.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry Orr whose telephone number is (571) 270 1308. The examiner can normally be reached on Monday thru Friday 8 to 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on (571) 272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

8/23/2007
HO

/Doug Hutton/
Supervisory Primary Examiner
Technology Center 2100